

SUPPORT FOR THE AMENDMENTS

Claims 20 and 73 have been amended to clarify the Markush language. No new matter is believed to have been added to the application by those amendments.

REMARKS

Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 are currently pending. Claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant currently intends to seek rejoinder of the withdrawn claims pursuant to MPEP § 821.04 upon indication of allowable subject matter.

As set forth in Claim 62, the present invention relates to a transfer-resistant composition for keratin materials, comprising:

(a) at least one non-volatile hydrocarbon-based oil with a molecular mass ranging from 230 to 420 g/Mol;

(b) a silicone component comprising one or more non-volatile silicone compound(s) which are compatible with the non-volatile hydrocarbon-based oil and which are selected from the group consisting of polydimethylsiloxanes, fluorosilicones, silicone resins, silicone gums, polydimethylsiloxanes comprising alkyl or phenyl groups, phenyl trimethicones, phenyl dimethicones, phenyl trimethylsiloxydiphenylsiloxanes, diphenyl dimethicones, diphenyl methyldiphenyltrisiloxanes, 2-phenylethyl trimethylsiloxysilicates, and mixtures thereof, wherein said non-volatile silicone component is present in an amount by mass of from 5 % to 60 %, based on the total mass of said composition;

(c) from about 0.1 to about 30% by weight of the total weight of the composition of an inert particulate phase; and

(d) from 0 to about 5% by weight of the total weight of the composition of a volatile oil,

wherein the composition does not contain a silicone compound which is alkoxyated.

The present invention also relates to a transfer-resistant composition comprising:

(a) at least one non-volatile hydrocarbon-based oil with a molecular mass ranging from 230 to 420 g/Mol;

(b) a silicone component comprising one or more non-volatile silicone compound(s) which are compatible with the non-volatile hydrocarbon-based oil and which are selected from the group consisting of polydimethylsiloxanes, fluorosilicones, silicone resins, silicone gums, polydimethylsiloxanes comprising alkyl or phenyl groups, phenyl trimethicones, phenyl dimethicones, phenyl trimethylsiloxydiphenylsiloxanes, diphenyl dimethicones, diphenyl methyldiphenyltrisiloxanes, 2-phenylethyl trimethylsiloxysilicates, and mixtures thereof,

(c) from about 0.1 to about 30% by weight of the total weight of the composition of an inert particulate phase; and

(d) from 0 to about 5% by weight of the total weight of the composition of a volatile oil,

wherein the composition does not contain a silicone compound which is alkoxyated.

See Claim 101.

In the Office Action dated June 10, 2010, Claims 5-10, 32-35, 37, 38, 39-42, 46, 48-51, 58, 83, 85-88, 91, 101, 111 and 112 have been rejected under 35 U.S.C. §103(a) over Mellul (U.S. 5,738,841). Claims 2-4, 11-19, 21-27, 31, 36, 44, 45, 47, 62-72, 74-78, 81, 82, 84, 89, 90, 92-95, 102, 105, 106, 109 and 110 have been rejected over the combination of Mellul with Jacks et al. (U.S. 5,690,918). Claims 5-10, 24-27, 31-35, 37-42, 44-51, 58, 62, 65-69, 77, 78, 81-83, 85-95, 101-102, 105-107 and 109-112 have been rejected over the combination of Mellul with Rokitoski (U.S. 5,750,127) and Arquette (U.S. 5,968,530).

Once again, the Office has resurrected rejections which had initially been raised years ago and which had been overcome, the result of which is a continued unfair prolongation of the prosecution of this case.

Previously, the Office rejected the claims in this application over Mellul and the combination of Mellul with Jacks et al. in the Office Action dated November 18, 2008. By virtue of the response submitted on February 19, 2009, this rejection was overcome.

As discussed therein, Mellul does not teach or suggest compositions having an inert particulate phase comprising 0.1 to 30% of the composition, but rather discloses compositions containing either 0%, 48% or 61%. In addition, the reference teaches that non-volatile silicone compounds and silicone compounds are interchangeable. Thus, Mellul does not teach, suggest or recognize the criticality of omitting volatile silicone compounds.

In the Office Action dated February 9, 2006, the Office withdrew the rejection under 35 U.S.C. 103 based on Mellul, recognizing that “Mellul also mentions the functional equivalency of the above non-volatile silicone oils with cyclomethicones, which are volatile oils...(Page 4).

For at least these same reasons, the currently pending rejections based on Mellul fail.

The secondary references Jacks et al., Rokitowski and Arquette each fail to remedies these deficiencies.

Regarding Jacks et al., as previously discussed (see, for example, Applicant’s response filed November 16, 2005), Jacks et al. relates to transfer-resistant compositions, and typically in such compositions volatile oil evaporates after application to form a transfer-resistant film. Jacks et al. recognizes this crucial role of volatile oils in his transfer-resistant compositions, stating that volatile oils contribute to the “wear characteristics” of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks et al. teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

One of the practical differences between the claimed invention and Jacks et al. is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks et al. requires the presence of a substantial amount of volatile oil. One skilled in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks et al. to remove or reduce volatile solvent because removing volatile solvent would affect the wear-

characteristics of these transfer-resistant products. In other words, Jacks et al. would lead one skilled in the art away from the claimed invention.

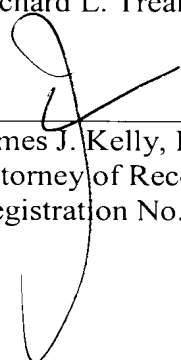
In view of the foregoing, the subject matter of the pending claims is not obvious over Mellul alone or in any combination with Jacks et al., Rokitowski and Arquette. Withdrawal of these grounds of rejection is respectfully requested.

The rejection of Claims 20 and 73 under 35 U.S.C. §112, second paragraph, is believed to be obviated by the amendment submitted above. The Markush language in those claims has been clarified. Accordingly, withdrawal of this ground of rejection is respectfully requested.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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